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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,530	01/16/2001	Mireille Maubru	05725.0828-00	2122

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,530	Applicant(s) MAUBRU ET AL.	
	Examiner Shengjun Wang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 20-34 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15, 23-29 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14, 16-18, 20-22, 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt of applicants' amendments and remarks submitted October 5, 2005 is acknowledged.
2. In view of the papers filed October 5, 2005, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of Sandrine Decoster.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claim Rejections 35 U.S.C 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-10, 12, 14, 16-18, 20-22 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweger et al. (US 5,482,704, of record) and Babenko (US 6,277,893) in view of Saint-Leger (US 5,919,438, of record), and Murray (US 5,720,964, of record).
3. Sweger et al. teach the usefulness of the amphoteric starch herein employed in cosmetic composition. The starch derivatives may be used as thickener or emulsion stabilizer, they

Art Unit: 1617

provide cosmetic composition with excellent aesthetic properties of skin feel and appearance.

See, particularly, col. 1, line 20 to col. 2, line 33. The starch derivatives may be employed in various cosmetic compositions, including skin care creams and lotion, the cosmetic composition may comprise various conventional cosmetic ingredients. The amounts of the starch derivatives employed are depending on the type of cosmetic compositions, but generally in the range of 0.1% to 20%. See, particularly, col. 4, line 39 to col. 6, line 40. The starch derivatives are superior to Carbopol (a conventional thickener and emulsion stabilizer) in respect of thickening and emulsion stabilizing properties. See, particularly, columns 8-9. Babenko teaches particularly a stable oil-in-water emulsion for use in cosmetic composition comprising the starch derivatives herein as emulsifier. The emulsion is particularly useful in compositions such as creams, lotions, antiperspirants, make-up products, sunscreens, shampoos and body cleansing products. See, particularly, the abstract, column 5, lines 20-40. Dimethicone, a polydimethylsiloxane is particularly useful in making the emulsion. See, particularly, col. 6, 10-32.

4. The primary references do not teach expressly a composition comprising each and every cosmetic ingredient herein listed, alkyl ether sulfate, the particular cationic polymer, polydimethylsiloxane, and coconut monoisopropanolamide, and without fatty acid soap.

5. However, Murray teaches a shampoo composition comprising alkyl ether sulfates, e.g., sodium laury ether sulfate, silicone emulsion, cationic polymers, such as polymer JR 400, and a thickener. See, particularly, the abstract, col. 3, line 36 to col. 6, line 45. Saint-Leger teaches that coconut monoisopropanolamide is particularly useful in shampoo composition, particularly with alkyl ether sulfate. See, particularly, the example 1, in col. 4. Further, none of the primary references require the present of fatty acid soap when amphoteric starch is used.

Art Unit: 1617

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the starch derivatives herein as emulsion stabilizer or thickener (as taught by Sweger et al. and Babenko) to make a cosmetic emulsion composition, and incorporate the conventional cosmetic ingredients herein disclosed to formulate a particular cosmetic composition, such as shampoo, and without using fatty acid soap.

A person of ordinary skill in the art would have been motivated to employ the starch derivatives herein as emulsion stabilizer or thickener (as taught by Swager et al. and Bambino) to make a cosmetic emulsion composition, and incorporate the conventional cosmetic ingredients herein disclosed to formulate a particular cosmetic composition, such as shampoo, and without using fatty acid soap because the starch derivatives have excellent aesthetic properties of skin feel and appearance, and are superior to conventional thickener or emulsion stabilizer. The employment of the particular ingredients herein, i.e., alkyl ether sulfate, the particular cationic polymer, polydimethylsiloxane, and coconut monoisopropanolamide, in a cosmetic composition, e.g., shampoo, is obvious to one of ordinary skill in the art because all these ingredients are old and well-known cosmetic ingredients, particularly in shampoo composition.

Response to the Arguments

Applicants' remarks submitted October 5, 2005 have been fully considered, but are unpersuasive.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

Art Unit: 1617

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion and motivation are found in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Sweger et al. teach many superior properties of the amphoteric starch herein employed in cosmetic composition. The secondary references teach the other ingredients herein employed are old and well-known cosmetic ingredients functioning as herein employed. One of ordinary skill in the art would have been motivated to incorporate the amphoteric starch in a cosmetic composition and enjoy an reasonable expectation of superior properties disclosed by the primary reference, absent evidence to the contrary. The motivation, or desirability, to employ the amphoteric starch in cosmetic composition is clear and convincing. One of ordinary skill in the art would have been motivated to combine not merely because that each and every ingredients herein are known cosmetic ingredients, but to take advantage of the superior cosmetic properties of the amphoteric starch herein.

7. Applicants' rebuttal argument regarding "obvious to try" are deemed unpersuasive. As stated in *In re O'Farrell*, 7 U.S.P.Q. 2d 1673 (CAFC 1988) "Rejection of patent application *cannot be* overturned on ground that examiner and Board of Patent Appeals and Interferences applied impermissible "obvious to try" standard, since assignment of error for application of such standard usually occurs when invention is made by varying all parameters or trying each of numerous choices *until successful without indication in prior art as to which parameters were critical or which choices were likely to be successful*, or when invention is made by exploring promising new technology or general approach with only general guidance from prior art as to

Art Unit: 1617

particular form of claimed invention or how to achieve it, and since neither situation is present in instant case.” (Emphasis added). In the instant situation, as in O’Farrell, there is no such critical parameter that is not obvious at the time the claimed invention was made. Applicants have failed to point out (and the examiner could not find) any successful story residing in the claimed invention, nor have applicants specified the critical parameter(s) that make the claimed invention patentable distinct from the prior art.

8. Regarding the teaching of Sweger et al, or Babenko et al, it is noted that nowhere in these references require the present of fatty acid soaps. It is well established that “Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. This application contains claims 37-44 drawn to an invention nonelected with traverse in Paper submitted November 30, 2001. A complete reply to the

Art Unit: 1617

final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER
Shengjun Wang
Primary Examiner
Art Unit 1617